

### **REMARKS**

Claims 68-72 and 111-124 are currently pending in the present application. Claims 68, 112, 116, and 124 have been amended. Reconsideration and allowance of the application is respectfully requested for the reasons set forth below.

#### **Rejections under 35 U.S.C. § 112**

Claim 124 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claim 124 has been amended to correctly recite a flexible shaft instead of a flexible housing. The revised claim is clearly supported in the original specification, including for example, page 24, first paragraph. Applicants respectfully request that this rejection be withdrawn.

#### **Rejections under 35 U.S.C. § 102**

Claims 68-70, 72, 111-114, 116-119, and 121-123 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,243,717 to Moreira ("Moreira"). Of the rejected claims, only claims 68, 111, 112, 116, and 121 are independent. Claims 68, 112, and 116 have been similarly amended to more clearly distinguish over Moreira. As a representative example of these claim amendments, claim 68 now recites:

68. An apparatus for repairing soft tissue, comprising:  
an elongate housing having a first end and a second end, said first end configured to receive a soft tissue anchor;  
a handle disposed proximate said second end of said housing;  
a tubular shaft disposed within said housing, said shaft rotatable within and movable along a longitudinal axis of said housing and having an inner bore extending lengthwise through at least a portion of said shaft;  
a driving member coupled with said shaft for rotation therewith and configured to engage the soft tissue anchor, whereby rotation of said shaft imparts rotation to the soft tissue anchor via said driving member;

an inner member disposed within said shaft and movable along said inner bore independently of said shaft and the soft tissue anchor, said inner member having an inner channel sized to receive an elongate tensile member or a shuttle member;

a first actuating member coupled to said shaft and configured to translate said shaft along said longitudinal axis of said housing when manipulated by a user; and

a second actuating member coupled to said inner member and configured to move said inner member along said inner bore between an extended position wherein said inner member extends beyond said first end of said housing and a retracted position wherein said inner member is substantially within said housing. (Emphasis added).

Moreira is directed to a device for driving a screw into a bone. Referring to Fig. 1 of Moreira, the device includes an outer wrench member (15) having a longitudinal bore (16). A neck (19) at an end of the outer wrench member (15) is threaded over an end portion (20) of a bone screw S so that the end portion (20) extends into the longitudinal bore (16). An inner wrench member (12) is inserted into the longitudinal bore (16) from an opposite end of the outer wrench member (15) and moved towards the bone screw S. An end (14) of the inner wrench member (12) is threaded over the end portion (20) of the bone screw S. A shoulder (13) on the exterior of the inner wrench member (12) contacts a shoulder (17) within the longitudinal bore (16) of the outer wrench member (15). This contact prevents further relative movement between the wrench members (12, 15). See col. 2, lines 43-49. The wrench members are then used to insert the bone screw S into a patient's bone. The bone screw S and wrench members (12, 15) may be advanced over a guide wire (10) to facilitate this insertion.

In the rejection of claims 68, 112, and 116, Examiner alleged that Moreira disclosed "an inner member (20) disposed within the shaft (12) and moveable along the inner bore." As emphasized above, these claims now recite "an inner member disposed

within the shaft and moveable along said inner bore independently of said shaft and the soft tissue anchor." In other words, the inner member can drive a needle or a guide wire through the soft tissue without disrupting the independent operation of the shaft and the soft tissue anchor. In contrast, the Examiner cited end portion (20) of bone screw S as the claimed inner member, the bone screw S as the claimed soft tissue anchor, and the inner wrench member (12) as the claimed shaft. It is clear that the end portion (20) cannot move independently of the bone screw S. Furthermore, the inner wrench member (12) engages the threads on end portion (20) in order to rotate end portion (20) and drive bone screw S. Under Examiner's recitation of elements in Moreira, the inner member cannot move independently of either the "shaft" or the "soft tissue anchor." This is directly contrary to the amended language of claims 68, 112, and 116. Consequently, Moreira fails to disclose each and every element of claims 68, 112, and 116.

Independent claims 111 and 121 each recite "a driving member coupled with said shaft for rotation therewith and configured to engage the soft tissue anchor...whereby rotation of said shaft imparts rotation to the soft tissue anchor via said driving member" (emphasis added). Thus, the shaft imparts rotation directly to the driving member, which imparts rotation directly to the soft tissue anchor. Specifically referring to claim 111, Examiner refers to end portion (20) of the bone screw S in Moreira as the "shaft," the inner wrench member (12) as the "driving member," and the bone screw S as the "soft tissue anchor." The end portion (20) does not impart rotation to the bone screw S "via" the inner wrench member (12), but instead, the inner wrench member (12) imparts rotation to the end portion (20) of the bone screw S. Examiner has therefore taken an unreasonable and unsupported interpretation of the claim

language. Consequently, Moreira fails to disclose each and every element of claims 111 and 121.

For at least these reasons, claims 68, 111, 112, 116, and 121 are allowable over Moreira. Each of the other claims in this rejection depends directly or indirectly from one of the aforementioned independent claims, and all dependent claims are allowable for the same reasons. Applicants respectfully request that these rejections be withdrawn.

#### **Rejections under 35 U.S.C. § 103**

Claims 71, 115, and 120 stand rejected under 35 U.S.C. § 103(a) as being obvious over Moreira in view of U.S. Patent No. 5,152,765 to Ross. Claim 124 stands rejected under 35 U.S.C. § 103(a) as being obvious over Moreira in view of U.S. Patent No. 6,319,257 to Carignan et al. Each of these rejected claims is indirectly dependent on the previously discussed independent claims. For the reasons provided above as to the independent claims, dependent claims 71, 115, 120, and 124 are also allowable. Applicants respectfully request that these rejections be withdrawn.

#### **Conclusion**

Applicants respectfully submit that the foregoing is a full and complete response to the Office Action mailed on September 30, 2008. If the Examiner believes any matter requires further discussion, the Examiner is respectfully invited to telephone the undersigned attorney so that the matter may be promptly resolved.

Applicants believe that no fees are due in connection with this response other than the extension fee. However, if such petition is due or any other fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

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